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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/849,574

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Edward Almond

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21378

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09/05/2008

APPLIED MEDICAL RESOURCES CORPORATION

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EXAMINER

SHELL, LAURA C

ART UNIT

PAPER NUMBER

3767

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/849,574	<b>Applicant(s)</b> ALMOND ET AL.	
	<b>Examiner</b> LAURA C. SCHELL	<b>Art Unit</b> 3767	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 3 and consequently all dependent claims are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitation "the carrier plate" in line 2. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 and 8-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Carlson et al. (US Patent No. 5,820,600). Carlson discloses a seal for a laparoscopic port comprising a base (8) adapted to engage a cannula, the base including an axial aperture (Figs. 4-5b: 62, 116) for a surgical instrument (Fig. 4, 130 for example); a multiplicity of jaws (Figs. 5a and 5b; 110) mounted on the base, the jaws being moveable radially with respect to the aperture between an open position wherein the

Art Unit: 3767

shaft of the surgical instrument may pass freely and the closed position wherein the jaws engage the shaft and provide a restraining force restraining radial movement of the shaft (Figs. 5a and 5b; col. 9, lines 53 through col. 10, lines 1-19 disclose that the jaws 110 move radially inward and slide along a track/groove that is not shown. These passages further disclose that the movement of jaws 110 may be "actuated by movement of ring 50 so that the size of central opening 116 corresponds to the size of aperture 62" col. 10, lines 15-18. Furthermore, col. 3, line 65 through col. 4, line 14 discloses that the second valve member 50 may be threadably coupled to the device so that rotation of 50 relative to the device causes the aperture to increase and decrease in size for sealing around different sized instruments. Therefore the jaws 110 can be moved by rotation.); and an actuator rotatable (element 50; Figs. 4-5b and col. 3, line 65 through col. 4, line 14) to urge the jaws to move between said open position and said closed position.

In reference to claim 2, Carlson discloses that the jaws may be adjusted to engage a shaft having any diameter between pre-selected upper and lower limits (Figs. 5a and 5b; col. 3, lines 65 through col. 4, line 14 disclose rotation and col. 6, line 3-6 disclose that rotation of the actuator is linked to discrete size settings/diameters).

In reference to claim 3, Carlson discloses that the jaws are moveable along guides on the carrier plate (col. 10, lines 9-12).

In reference to claim 4, Carlson discloses that the guides comprise channels between raised formations, tracks or runners (Figs. 5a and 5b; col. 10, lines 9-12).

In reference to claim 5, Carlson discloses that each jaw comprises a follower member adapted to be received in a respective guideway in an actuator arranged so that the rotation of the actuator causes radial movement of the jaw (figs. 4-5b; col. 10, lines 9-12).

In reference to claim 8, Carlson discloses a diaphragm adapted to contact the shaft of a surgical instrument extending through the aperture (Figs. 4-5b, 60).

In reference to claim 9, Smith discloses that the diaphragm includes a lip, each jaw including a radially outwardly facing portion adapted to engage the lip so that the aperture of the diaphragm is forced to open as the jaws move to an open position (Fig. 5b).

In reference to claim 10, Carlson discloses that the aperture of the jaws is continuously adjustable between maximum and minimum positions (Fig. 5a).

In reference to claim 11, Carlson discloses that the jaws may be fully opened or closed by a rotation through an angle of 30-180 degrees (Figs. 1, 5a and 5b; col. 6, lines 3-6 and col. 3, lines 65 through col. 4, line 14).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carlson et al. (US Patent No. 5,820,600). Carlson discloses the device substantially as claimed including that there are channels/tracks for the jaws to move along (col. 3, lines 65 through col. 4, line 14), however, Carlson does not disclose what shape these tracks/channels are. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Carlson's tracks to be shaped in parabolic curves and/or arcuate channels since it has been held that a change in shape is generally recognized as being within the level of ordinary skill in the art.

Claims 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carlson et al. (US Patent No. 5,820,600) in view of Smith (US Patent No. 7,025,747). Carlson discloses the device substantially as claimed except for shield members moving with and covering the jaws. Smith, however, discloses a similar device (Figs. 15-18b) with jaws that are rotated (Figs. 18a and 18b, 960 for example) to engage the instrument as well as shield members (969 for example). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified

Art Unit: 3767

Carlson with the shield members, as taught by Smith, in order to provide shielding and protection for the moving mechanisms to prolong the use of the device and protect it from premature wear and tear.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LAURA C. SCHELL whose telephone number is (571)272-7881. The examiner can normally be reached on Monday-Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Simons can be reached on (571) 272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3767

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Laura C Schell/

Examiner, Art Unit 3767

/Kevin C. Sirmons/

Supervisory Patent Examiner, Art Unit 3767